

Application Serial No. 09/923,713

Claims 1-8 and 11-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,304,006 to Jungreis in view of U.S. Patent No. 6,055,163 to Wagner. The Examiner stated that Jungreis shows a controller with a computer control unit, a utility power grid sensor input, and a utility grid power inverter command output line. The Examiner further stated that the computer control unit causes automatic transitions of the generator system, including a generator standby backup mode and a transfer to standby backup mode. The Examiner further states that Jungreis does not disclose a utility power grid disconnect, a generator standalone mode, or a generator startup battery charging mode. The Examiner, however, stated that Wagner shows a utility power grid disconnect command output line.

The Applicant respectfully traverses the rejection of Claims 1 and 11 and the dependent claims thereon. As stated in Paragraph 0001 herein, the present invention is not concerned with a standard backup generator that typically only has on and off modes. Jungreis, however, is more concerned with such on and off operation:

The auxiliary generator 18 may provide power to the system after a grid failure. The auxiliary generator need only be started. No synchronizing is required because the generator 18 outputs power to a dc bus rather than to an ac power supply.

See Col. 3, lines 1-5.

As such, Jungreis does not show a transfer to standalone mode. Likewise, Jungreis does not show a transfer to standby backup mode or a generator startup battery charging mode. Without such a disclosure, the Applicant respectfully submits that Claims 1 and 11 are patentable. The cited references simply do not teach or suggest each of the claim limitations recited herein. See MPEP §2143.03 ("[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitation must be taught or suggested in the prior art.") Further, the

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missing limitations cannot be considered inherent in the cited references. MPEP §2112 (“[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art”, quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in the original)). The claimed transitional limitations and the battery charging limitation are not shown and such limitations cannot be considered to be required or necessary in any type of utility system. Rather, Jungreis teaches that such limitations are not necessary, *i.e.*, “the generator need only be started.”

The Applicant further traverses the rejection of Claims 2 and 12 concerning a transfer to standalone mode. The cited references are silent on any type of transitional state.

The Applicant further traverses the rejection of Claims 4 and 14 concerning a transition to generator standalone mode, including disconnecting the load from the grid and connecting the load to the generator. The cited references appear to be silent on disconnecting the load from the grid. Rather, Jungreis appears to be more directed towards peak shaving.

The Applicant further traverses the rejection of Claims 5 and 15 concerning the transfer to standby backup mode. The cited references appear to be silent on any type of transitional state. Although the Examiner stated that it would have been obvious to one of ordinary skill in the art to include a power-down sequence, the fact remains that the limitations are not disclosed in any of the cited references and such a transitional sequence need cannot be considered inherent. As quote above in Jungreis, no power up sequence is required. Likewise, no power down sequence is shown or necessary.

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The Applicant further traverses the rejection of Claims 6 and 16 concerning the transition to generator startup battery charging mode. The cited references are silent on any type of transitional state.

The Applicant further traverses the rejection of Claims 7 and 17 concerning the transition to generator start up battery charging mode at periodic intervals. The cited references are silent on any type of transitional state.

Claims 9 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jungreis in view of Wagner and in further view of U.S. Patent No. 6,476,697 to Swartzentruber. The Applicant respectfully traverses the rejection for the reasons given above.

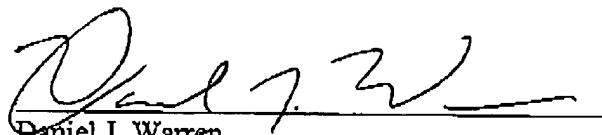
Claims 10 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jungreis in view of Wagner. The Applicant respectfully traverses the rejection for the reasons described above.

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CONCLUSION

The Applicant believes that it has responded to each matter raised in the Office Action. Allowance of the claims is respectfully solicited. Any questions may be directed to the undersigned at (404) 853-8028.

Respectfully submitted,



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